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Technology Center 2100

In re Application of:)
Richard Sinn)
Application No. 09/998914) **DECISION ON PETITION TO**
Filed: November 30, 2001) **WITHDRAW THE 37 CFR 1.105**
For: Obtaining and Maintaining Real Time) **REQUIREMENT FOR**
Certificate Status) **INFORMATION**
)

This is a decision on the petition, filed on 29 March 2006, under 37 CFR 1.181 to withdraw the requirement for information under 37 CFR 1.105.

The petition is **Granted**.

Applicant states that it is an inappropriate time for a 37 CFR 1.105 requirement for information when the application is under a final rejection and that the requirement for information is being improper as it states that the references were placed in the file and not considered.

REGULATION AND PROCEDURES

37 CFR 1.105(a)(3) states that:

Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

- (i) A requirement for factual information;
- (ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or
- (iii) Stipulations as to facts with which the applicant may agree or disagree.

MPEP § 704.11(a) states that:

...
(S) Interrogatories or Stipulations.

- (1) Of the common technical features shared among all claims, or admission that certain groups of claims do not share any common technical features,

- (2) About the support found in the disclosure for means or steps plus function claims (35 U.S.C. 112, paragraph 6),
- (3) Of precisely which portion(s) of the disclosure provide the written description and enablement support for specific claim element(s),
- (4) Of the meaning of claim limitations or terms used in the claims, such as what teachings in the prior art would be covered by particular limitations or terms in a claim and which dictionary definitions would define a particular claim term, particularly where those terms are not used per se in the specification ...

MPEP § 704.11(b) states:

A requirement for information under 37 CFR 1.105 is discretionary. **A requirement may be made at any time once the necessary for it is recognized** and should be made at the earliest opportunity after the necessity is recognized ... [emphasis added.]

MPEP § 704.11(b)(III) states:

A requirement for information made after the first action on the merits may be appropriate when the application file justifies asking the applicant if he or she has information that would be relevant to the patentability determination. It is rarely appropriate to require information because of a lack of relevant prior art after the first action on the merits.

A requirement for information is not proper when no further action would be taken by the examiner. The reasonable necessity criteria for a requirement for information implies further action by the examiner. This means that actions in which requirements for information necessary for examination are made should generally be a non-final action because the applicant's reply must be considered and applied as appropriate.

MPEP § 1214.04 states in pertinent part:

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection...

Relevant Facts

On 14 July 2005, a first office on the merits was mailed out including an initialed and signed 1449 that indicated that the examiner considered the SiteMinder documents.


On 30 January 2006, a final office action was mailed out and a rule 105 request was included for the first time requiring an explaining of relevancy and a statement as why the SiteMinder documents were cited. The 105 request stated that the SiteMinder references have been place in the file and have not been considered.

Decision

As the rule 105 request was first introduced at the time of the final rejection it is improper and therefore the Petition is **GRANTED** and the rule 105 requirement is hereby vacated. As the references have been considered no further action is required on this matter.

Any question concerning this decision should be directed to Tod Swann whose telephone number is 571-272-3612.

A new final rejection has been mailed out as of February 16, 2006 and the period for response on that action continues to run.



James Dwyer, Director
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